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10/721,595	11/26/2003	Masatomo Matsubara	325772033300	5975
<div>7590 Barry E. Bretschneider Morrison & Foerster LLP Suite 300 1650 Tysons Boulevard McLean, VA 22102</div>				
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<div>EXAMINER RUDOLPH, VINCENT M</div>				
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary**Application No.**

10/721,595

Applicant(s)

MATSUBARA ET AL.

Examiner

Vincent Rudolph

Art Unit

2625

Period for Reply -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 12 January 2011.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1 and 3-24 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1 and 3-24 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 26 November 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-945)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 1/12/2011 has been entered.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

Claims 11-14 are rejected under 35 U.S.C. 102(a) as being anticipated by Yamade (Pub. # 20030107777).

Regarding claim 11, Yamade (Pub. # 20030107777) discloses an image managing apparatus (information processor, **See Figure 1, Element 2**) that includes a receiving portion (serial interface, **See Figure 1, Element 83**) receiving image-related information related to image data stored on an image forming apparatus, wherein the image-related information includes a thumbnail image corresponding to the image data (receives thumbnail images corresponding to each scanned page of the document, **See Page 3, Paragraph 0056**, stored in the photocopier, **See Page 3, Paragraph 0061**), a

display portion (display, **See Figure 1, Element 75**) displaying the image-related information (displays the thumbnails received on the screen, **See Figure 4; Page 3, Paragraph 0064**), and output form instruction information producing portion (embodied within the information processor, **See Figure 1, Element 2**) producing output form instruction information that includes an instruction relating to an output form of the image data held in the image forming apparatus, such that the output form determined by a user based on the received image-related information (the user is able to specify the output sequence of the output images by rearranging the thumbnail images into a preferred order, **See Figure 5; Page 3, Paragraph 0058**) and a sending portion (serial interface, **See Figure 1, Element 83**) sending the output form instruction information to the image forming apparatus (sends the sequence for the output images to the photocopier, **See Page 3, Paragraph 0058**).

Regarding claim 12, Yamade (Pub. # 20030107777) discloses that the image managing apparatus also includes an accepting portion (embodied within the information processor, **See Figure 1, Element 2**) accepting an instruction operation using the thumbnail image and performed by a user for an output form (the user specifies a desired output sequence of the original document via a drag and drop operation, **See Figure 4; Page 3, Paragraph 0065**).

Regarding claim 13, Yamade (Pub. # 20030107777) discloses that the output form instruction information producing portion produces, as the output form, the output form instruction information instructing a print output of the image data (once the

sequence is confirmed, the user instructs to have them printed in the specified order via an instruction sent to the photocopier, **See Page 3-4, Paragraph 0068**).

Regarding claim 14, Yamade (Pub. # 20030107777) discloses that the image data is obtained by scanning of documents forming a document group (the photocopier scans the document and generates thumbnail images for each page of the document, **See Page 3, Paragraph 0056**), the image-related information received from the image forming apparatus includes image-related information for each of the documents (receives a thumbnail representing each page of the document, **See Page 3, Paragraph 0056**), and the output form instruction information producing portion produces the output form instruction information instructing an output form of each of the documents (produces the preferred sequence of each page within the document for outputting, **See Page 3-4, Paragraph 0068**).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-4, 8, and 18, 20 and 22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Yamade (Pub. # 20030107777) in view of Berkema (Pub. # 20030002072).

Regarding claim 1, Yamade (Pub. # 20030107777) discloses an image forming apparatus (photocopier, **See Figure 1, Element 1**) that includes a holding portion

(RAM, **See Figure 1, Element 21**) holding obtained image data (stores the scanned images, **See Page 3, Paragraph 0061**), an image-related information producing portion (embodied within the photocopier, **See Figure 1, Element 1**) producing image-related information related to the image data, which includes a thumbnail image corresponding to the image data (produces a thumbnail image for each page within the document, **See Page 3, Paragraph 0056**), an operation portion (embodied within the photocopier, **See Figure 1, Element 1**) designating an external device as a sending destination of the image-related information corresponding to the image data held in the holding portion (designates the information processor, **See Figure 1, Element 2**, for exchanging data through the serial interface, **See Page 2, Paragraph 0045**, of data generated and stored within the photocopier, **See Page 3, Paragraph 0061**), a sending portion (serial interface, **See Figure 1, Element 25**) automatically sending the image-related information corresponding to the image data held in the holding portion to an external device at the designated destination (automatically sends the thumbnail images to the information processor, **See Page 3, Paragraph 0056**, once generated and stored at the photocopier, **See Page 3, Paragraph 0061**), a receiving portion (serial interface, **See Figure 1, Element 25**) receiving output form instruction information from the external device, such that the output form instruction includes an instruction relating to an output form of the image data and determined by the user based on the image-related information (receives an instruction from the user via the information processor, **See Figure 5; Page 3-4, Paragraph 0068**, specifying the output sequence of the output images by rearranging the thumbnail images into a preferred order, **Page 3, Paragraph**

0058), and an image forming portion (printing section, **See Figure 1, Element 41**) forming image data for output from the image data held by the holding portion based on the received output form instruction information (the photocopier prints the scanned images according to the output sequence specified by the user, **See Page 3, Paragraph 0061**).

Yamade (Pub. # 20030107777) does not disclose that an external device is designated in response to a user input on the operation portion.

Berkema (Pub. # 20030002072) discloses that the image forming apparatus (print device, **See Figure 1, Element 106**) includes an operating portion (embodied within the print device) accepting a user input designating an external device as a sending destination of image-related information (the print device accepts user input for selecting a sending destination, **See Page 2-3, Paragraph 0022**, such that the image related information is included within the data set, **See Page 3, Paragraph 0025**).

It would have been obvious to one of ordinary skill in the art at the time of the invention by the applicant to include accepting user input for an external destination for sending image related information, such as the one disclosed within Berkema (Pub. # 20030002072), and incorporate it into the apparatus of Yamade (Pub. # 20030107777) because it allows the user the ability to select a destination that is best suited to assist for outputting the image data accordingly.

Regarding claim 3, Yamade (Pub. # 20030107777) discloses the receiving portion receives, as an output form, the output form instruction information instructing

the print output of the image data (receives an instruction from the user to have the images printed in the specified page order, **See Page 3-4, Paragraph 0068**).

Regarding claim 4, Yamade (Pub. # 20030107777) discloses that the image data is obtained by scanning of documents forming a document group (the photocopier scans the document and generates thumbnail images for each page of the document, **See Page 3, Paragraph 0056**), the image-related information produces image-related information for each of the documents (produces a thumbnail representing each page of the document, **See Page 3, Paragraph 0056**), and the receiving portion receives the output form instruction information instructing an output form of each of the documents (receives the preferred sequence of each page within the document for outputting, **See Page 3-4, Paragraph 0068**).

Regarding claim 18, the combination of Yamade (Pub. # 20030107777) and Berkema (Pub. # 20030002072) together discloses that the image-related information includes color information of the image data (the colors of the image data, **See Berkema (Pub. # 20030002072), Page 3, Paragraph 0025**).

Regarding claim 20, Yamade (Pub. # 20030107777) discloses that the image data is obtained by scanning (scans the document to produce a thumbnail for each page of the document, **See Page 3, Paragraph 0056**).

Regarding claims 8 and 22, the rationale provided in the rejection of claims 1, 11 and 20 is incorporated herein. In addition, the apparatus of claims 1, 11 and 20 corresponds to the method of claims 8 and 22 and performs the steps disclosed herein.

Claims 15-17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Yamade (Pub. # 20030107777) in view of Phillips (Pub. # 20040205504).

Regarding claim 15, Yamade (Pub. # 20030107777) discloses an image managing apparatus (information processor, **See Figure 1, Element 2**) that includes a receiving portion (serial interface, **See Figure 1, Element 83**) receiving a first thumbnail image related to image data held in an image forming apparatus (receives thumbnail image data corresponding to a scanned page of the document, **See Page 3, Paragraph 0056**, stored in the photocopier, **See Page 3, Paragraph 0061**), and a sending portion (serial interface, **See Figure 1, Element 83**) sending instruction information providing an instruction related to the reproduction of a thumbnail image concerning the first thumbnail image to the image forming apparatus (sends information providing the specific order for the reproducing the images to the photocopier as determined from the thumbnail sequence, **See Figure 5; Page 3, Paragraph 0058**).

While Yamade (Pub. # 20030107777) does disclose sending instruction information includes an instruction relating to an output from the image data held in the image forming apparatus and determined by a user (the user is able to specify the output sequence by rearranging the thumbnail image data into a preferred order and send the instruction sequence for the output images to the photocopier, **See Figure 5; Page 3, Paragraph 0058**), Yamade (Pub. # 20030107777) does not fully disclose receiving a second thumbnail image reproduced at the image forming apparatus in compliance with the instruction information sent from the image managing apparatus to the image forming apparatus.

Phillips (Pub. # 20040205504) discloses a receiving portion (embodied within the server, **See Figure 1, Element 140**) receiving another thumbnail image reproduced at the image forming apparatus complying with the instruction information sent from the image managing apparatus to the image forming apparatus (receives a request for scrolling through different thumbnail images relating to configuration changes, **See Page 2, Paragraph 0030**).

It would have been obvious to one of ordinary skill in the art at the time of the invention by the applicant to include a receiving and sending an instruction for reproducing a thumbnail image, such as the one disclosed within Phillips (Pub. # 20040205504), and incorporate it into the image forming apparatus of Yamade (Pub. # 20030107777) because it provides assistance to the user in scrolling and modifying a selected thumbnail image in order to determine the preferred setting for outputting.

Regarding claim 16, the combination of Yamade (Pub. # 20030107777) and Phillips (Pub. # 20040205504) together discloses that the instruction related to the thumbnail image instructs at least one of change of the thumbnail image and resending the abbreviated image (client sends a change request and receives it in response in order for the client to process the received configurations change, **See Phillips (Pub. # 20040205504), Page 2, Paragraph 0027**).

Regarding claim 17, the combination of Yamade (Pub. # 20030107777) and Phillips (Pub. # 20040205504) together discloses that the instruction related to the thumbnail image instructs the resolution of the thumbnail image (resolution of the thumbnails, **See Phillips (Pub. # 20040205504), Page 3, Paragraph 0037**).

Claims 5-7, 9-10, 15-17, 19, 21 and 23-24 are rejected under 35 U.S.C. 103(a) as being unpatentable over Yamade (Pub. # 20030107777) in view of Berkema (Pub. # 20030002072) and Phillips (Pub. # 20040205504).

Regarding claim 5, Yamade (Pub. # 20030107777) discloses an image forming apparatus (photocopier, **See Figure 1, Element 1**) that includes a holding portion (RAM, **See Figure 1, Element 21**) holding obtained image data (stores the scanned images, **See Page 3, Paragraph 0061**), a thumbnail image producing portion (embodied within the photocopier, **See Figure 1, Element 1**) producing a first thumbnail image corresponding to the image data held in the holding portion (produces a thumbnail image for a page within the document, **See Page 3, Paragraph 0056**, from the images scanned and stored within the photocopier, **See Page 3, Paragraph 0061**), an operation portion (embodied within the photocopier, **See Figure 1, Element 1**) designating an external device as a sending destination of the first thumbnail image (designates the information processor, **See Figure 1, Element 2**, for exchanging data through the serial interface, **See Page 2, Paragraph 0045**, of thumbnail image data scanned and generated within the photocopier, **See Page 3, Paragraph 0056**), a sending portion (serial interface, **See Figure 1, Element 25**) automatically sending the produced first thumbnail image to the designated external device (automatically sends the thumbnail data to the information processor once generated, **See Page 3, Paragraph 0056**), and a receiving portion (serial interface, **See Figure 1, Element 25**) receiving a setting from the external device, such that the setting is relating to a thumbnail image (receives a setting from the user via the information processor, **See**

Figure 5; Page 3-4, Paragraph 0068, specifying the output sequence of the thumbnail image, **Page 3, Paragraph 0058**).

Yamade (Pub. # 20030107777) does not disclose that an external device is designated in response to a user input on the operation portion.

Berkema (Pub. # 20030002072) discloses that the image forming apparatus (print device, **See Figure 1, Element 106**) includes an operating portion (embodied within the print device) accepting a user input designating an external device as a sending destination of image-related information (the print device accepts user input for selecting a sending destination, **See Page 2-3, Paragraph 0022**, such that the image related information is included within the data set, **See Page 3, Paragraph 0025**).

It would have been obvious to one of ordinary skill in the art at the time of the invention by the applicant to include accepting user input for an external destination for sending image related information, such as the one disclosed within Berkema (Pub. # 20030002072), and incorporate it into the apparatus of Yamade (Pub. # 20030107777) because it allows the user the ability to select a destination that is best suited to assist in outputting the image data accordingly.

Yamade (Pub. # 20030107777) further does not disclose when receiving the setting from the external device related to a thumbnail image, a second thumbnail image is produced that corresponds to the image data based on the received setting, and sending the second thumbnail image to the designated external device.

Phillips (Pub. # 20040205504) discloses receiving a setting from an external device, such that the setting relates to a thumbnail image (client receives a confirmation

on the user change from the server that was requested, such as a configuration changes related to thumbnail images, **See Page 2, Paragraph 0027**), and producing another thumbnail image based on the received setting and sending it to the designated external device (user is able to enter a different configuration for the related thumbnail image, **See Figure 6; Page 2, Paragraph 0030**).

It would have been obvious to one of ordinary skill in the art at the time of the invention by the applicant to include a setting for a thumbnail image and producing it, such as the one disclosed within Phillips (Pub. # 20040205504), and incorporate it into the image forming apparatus of Yamade (Pub. # 20030107777) because it allows the user to scroll and modify a selected thumbnail image in order to determine the preferred setting for outputting.

Regarding claim 6, the combination of Yamade (Pub. # 20030107777), Berkema (Pub. # 20030002072) and Phillips (Pub. # 20040205504) discloses that the receiving portion receives the setting designating a resolution of the thumbnail image (resolution of the thumbnails, **See Phillips (Pub. # 20040205504), Page 3, Paragraph 0037**).

Regarding claim 7, the combination of Yamade (Pub. # 20030107777), Berkema (Pub. # 20030002072) and Phillips (Pub. # 20040205504) together discloses that the setting received by the receiving portion from the external device designates at least one of change of the thumbnail image and resending of the thumbnail image (client sends a change request and receives it in response in order for the client to process the received configurations change related to the thumbnail image, **See Phillips (Pub. # 20040205504), Page 2, Paragraph 0027**).

Regarding claim 19, the combination of Yamade (Pub. # 20030107777), Berkema (Pub. # 20030002072) and Phillips (Pub. # 20040205504) together discloses that the operation portion includes a user interface provided on the image forming apparatus (control panel, **See Yamade (Pub. # 20030107777), Figure 2**) that accepts the user input designating the external device (the print device accepts user input for selecting a sending destination, **See Berkema (Pub. # 20030002072), Page 2-3, Paragraph 0022**).

Regarding claims 21, Yamade (Pub. # 20030107777) discloses that the image data is obtained by scanning (scans the document to produce a thumbnail for each page of the document, **See Page 3, Paragraph 0056**).

Regarding claims 9-10 and 23-24, the rationale provided in the rejection of claims 5, 15 and 21 is incorporated herein. In addition, the image forming apparatus of claims 5, 15 and 21 corresponds to the image forming method of claims 9-10 and 23-24 and performs the steps disclosed herein.

Response to Arguments

Applicant's arguments, see remarks, filed 1/12/2011, with respect to the rejection of claims 1-4, 8, 11-14, 18, 20 and 22 under Umebayashi in view of Berkema as well as claims 5-7, 9-10, 15-17, 19, 21 and 23-24 under Umebayashi in view of Berkema and Phillips have been fully considered and are persuasive. Therefore, the rejection has been withdrawn. However, upon further consideration, a new ground of rejection is made in view of Yamade as applied to claim 11-14, Yamade in combination with Berkema as applied to claims 1-4, 8, and 18, 20 and 22, Yamade in combination with

Phillips as applied to claims 15-17 as well as Yamade in combination with Berkema and Phillips as applied to claims 5-7, 9-10, 15-17, 19, 21 and 23-24. Thus, the newly cited prior art of Yamade is used, and together with the above mentioned prior arts does meet each limitation of the amended claims as fully disclosed within the rejection above.

Based on these facts, **THIS ACTION IS MADE NON-FINAL.**

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Vincent Rudolph whose telephone number is (571) 272-8243. The examiner can normally be reached on M-F 8:30 A.M. - 5 P.M.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Moore can be reached on (571) 272-7437. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only.

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Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Vincent Rudolph
Examiner
Art Unit 2625

/Vincent Rudolph/
Examiner, Art Unit 2625